REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1-12, 14-19 and 21-29 remain pending in the case. Claims 1-12, 14-19 and 21-29 are rejected. Claims 1, 8, 19 and 25 are amended herein. No new matter has been added as a result of the claim amendments.

103(a) Rejections - Claims 1-4, 7-11, 14, 16-19, 21, 23 and 24

The instant Office Actions states that Claims 1-4, 7-11, 14, 16-19, 21, 23 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shen et al. ("Shen"; U.S. Patent No. 6,950,464) in view of Uenoyama et al. ("Uenoyama"; U.S. Patent No. 6,798,837). The Applicants have reviewed the cited references and respectfully submit that the present invention as recited in Claims 1-4, 7-11, 14, 16-19, 21, 23 and 24 is not rendered obvious by Shen and Uenoyama, alone or in combination.

Applicants respectfully direct the Examiner to independent Claim 1 that recites that an embodiment of the present invention is directed to (emphasis added):

> A method for reducing the resolution of media data, said method comprising:
>
> accessing compressed input data for a frame of a plurality of frames, wherein said frame is at a first resolution and comprises a plurality of macroblocks, wherein said plurality of macroblocks comprises a plurality of subsets of macroblocks that are to be encoded as a single output macroblock;
>
> <u>selecting a data processing function according to the number of macroblocks in a subset of said plurality of subsets that are characterized as intra-coded, wherein said selecting is performed for each of said plurality of subsets;</u>
>
> if less than all of said macroblocks in said subset are characterized as intra-coded and if said number of macroblocks in said subset characterized as intra-coded satisfies a threshold, downsampling said subset of macroblocks to generate said output macroblock comprising compressed downsampled data at a second resolution that is reduced relative to said first resolution,

wherein said accessing, selecting and downsampling are
performed prior to transmitting over a wireless network; and
transmitting said output macroblock comprising
compressed downsampled data to a wireless device over said
wireless network.

Independent Claims 1, 8 and 19 recite similar limitations. Claims 2-4 and 7

that depend from independent Claim 1, Claims 9-11, 14 and 16-18 that depend

from independent Claim 8, and Claims 21, 23 and 24 that depend from

independent Claim 19 also recite these limitations.

Applicants respectfully submit that Shen and the claimed invention are

very different. Applicants understand Shen to teach a system for providing

video data pass through such that some video data is not transcoded during

video data delivery (Abstract). Shen discloses a network device comprising "a

rate controller designed or configured to selectively pass through macroblock

data in the compressed video data" (col. 2, lines 55-57). Specifically, Shen

discloses a system in which portions of a picture that need no rate reduction

can be passed through without transcoding (col. 2, lines 41-43). In particular,

Applicants respectfully submit that Shen does not teach, describe or suggest

"selecting a data processing function according to the number of macroblocks

in a subset of said plurality of subsets that are characterized as intra-coded,

wherein said selecting is performed for each of said plurality of subsets;"

(emphasis added) as claimed.

With reference to Figure 2 of Shen, network device 20 including pass

through apparatus 30 is shown. Applicants respectfully submit that when

picture, slice or macroblock data is passed through, that no data processing is

selected or performed on the passed through data. For instance, Shen specifically recites that "[w]hen picture pass through 40 receives a signal from rate controller 29 to this effect, picture pass through 40 directly copies picture data for the current picture from buffer 24 to output buffer 32 (emphasis added; col. 9, lines 21-24). In particular, Applicants understand Shen to teach the selection of whether or not to process data, rather than selecting how to process all the data.

In contrast, embodiments of the claimed invention are directed towards a method for reducing the resolution of media data, including "selecting a data processing function according to the number of macroblocks in a subset of said plurality of subsets that are characterized as intra-coded, wherein said selecting is performed for each of said plurality of subsets", as claimed (emphasis added). Applicants submit that the claimed embodiments recite that a data processing function is selected for each subset of macroblocks. In other words, each subset is processed according to a selected data processing function.

As described above, Applicants respectfully submit that Shen does not teach, describe or suggest including "selecting a data processing function according to the number of macroblocks in a subset of said plurality of subsets that are characterized as intra-coded, wherein said selecting is performed for each of said plurality of subsets" (emphasis added) as claimed. In contrast, by teaching that some data is selected to pass through without processing, Shen teaches away from the claimed embodiments.

Applicants have reviewed Uenoyama and do not understand Uenoyama to overcome this deficiency. Applicants respectfully assert that the combination of Shen and Uenoyama does not teach, describe or suggest the invention as claimed because the combination of the Shen and Uenoyama does not satisfy the requirements of a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" (MPEP 2142). Moreover, "[i]t is improper to combine references where the references teach away from their combination" (MPEP 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). In particular, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)" (MPEP 2143.01). Applicants respectfully note that "[a] prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2131.02; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Furthermore, "if the proposed modification or combination of the prior art <u>would change the principle of operation</u> of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Moreover, "[i]f the proposed

modification would render the prior art invention being modified <u>unsatisfactory</u> <u>for its intended purpose</u>, then there is no suggestion or motivation to make the proposed amendment" (emphasis added) (MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

As described above, Applicants understand Shen to disclose a system for providing video data pass through such that some video data is not transcoded during video data delivery (Abstract). With reference to Figure 2 of Shen, network device 20 is operable to pass through data without performing on processing on the data. Shen specifically recites that "[w]hen picture pass through 40 receives a signal from rate controller 29 to this effect, picture pass through 40 <u>directly copies</u> picture data for the current picture from buffer 24 to output buffer 32 (emphasis added; col. 9, lines 21-24). In particular, Applicants understand Shen to teach the selection of whether or not to process data, rather than selecting how to process all the data.

In particular, Applicants respectfully submit that <u>intended purpose</u> of Shen is to pass through some data <u>without</u> processing the passed through data. In other words, Applicants submit that <u>the principle of operation</u> of Shen is to provide expedited compressed video delivery by <u>passing through</u> data without performing any processing on the data (see col. 2, lines 36-38).

In contrast, Applicants understand Uenoyama to disclose "[a] video coding apparatus and a method thereof for coding a digital compressed video signal having a compression format to obtain a digital coded video signal having the same, or different compression format" (col. 1, lines 7-11). In

particular, Applicants submit that coding data requires that all data is processed. Specifically, Applicants understand Uenoyama to teach a system in which all data received is coded, and therefore that all data is processed. Indeed, Applicants respectfully submit that intended purpose of Uenoyama is to code video data. In other words, Applicants submit that the principle of operation of Uenoyama is to process all data of an input data stream.

Applicants respectfully submit that modifying Shen in the manner suggested by the Examiner would render Shen inoperable for its intended purpose. For instance, Shen discloses the selective processing of video data. In contrast, Uenoyama discloses a system in which all video data is processed. As recited above, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (MPEP 2131.02). Applicants respectfully submit that by modifying Shen in the manner suggested by the Examiner, would require that all data be processed, thus rendering Shen inoperable for its intended purpose.

Moreover, Applicants respectfully submit that Uenoyama teaches away from combination with Shen as suggested by the Examiner. For instance, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to combine the teachings of Uenoyama directed towards selective data processing of Shen, as the video coding of Uenoyama teaches away from the selective data processing of Shen.

In view of the combination of Shen in view of Uenoyama not showing or suggesting all of the limitations of independent Claims 1, 8 and 19 and not

satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully submit that independent Claims 1, 8 and 19 overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance. Applicants respectfully submit the combination of Shen in view of Uenoyama also does not teach or suggest the additional claimed features of the present invention as recited in Claims 2-4 and 7 that depend from independent Claim 1, Claims 9-11, 14 and 16-18 that depend from independent Claim 8, and Claims 21, 23 and 24 that depend from independent Claim 19. Therefore, Applicants respectfully submit that Claims 2-4, 7, 9-11, 14, 16-18, 21, 23 and 24 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claim.

103(a) Rejections - Claims 5, 6, 12, 15, 22 and 25-29

The instant Office Actions states that Claims 5, 6, 12, 15, 22 and 25-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shen and Uenoyama further in view of Vetro et al. ("Vetro;" U.S. Patent No. 6,671,322). Claims 5 and 6 depend from independent Claim 1, Claims 12 and 15 depend from independent Claim 8, and Claim 22 depends from independent Claim 19.

The Applicants have reviewed the cited references and respectfully submit that the present invention as recited in Claims 5, 6, 12, 15, 22 and 25-29 is not rendered obvious by Shen, Uenoyama and Vetro, alone or in combination.

As presented above, Applicants respectfully assert that Shen and Uenoyama, alone or in combination, do not show or suggest all of the

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limitations of independent Claims 1, 8 and 19 and do not satisfy the requirements of a *prima facie* case of obviousness. By similar rationale, Applicants respectfully submit that Shen and Uenoyama, alone or in combination, do not show or suggest all of the limitations of independent Claim 25.

Applicants respectfully submit that Vetro does not overcome the shortcomings of Shen and Uenoyama. That is, Applicants respectfully submit that Vetro, alone or in combination with Shen and Uenoyama, does not show or suggest the claimed embodiments.

Applicants respectfully assert that the combination of Shen, Uenoyama and Vetro does not teach, describe or suggest the invention as claimed because the combination of the Shen, Uenoyama and Vetro does not satisfy the requirements of a *prima facie* case of obviousness. So as to not unnecessarily duplicate arguments, Applicants respectfully direct the Examiner to the remarks accompanying the discussion of the rejection of Claims 1-4, 7-11, 14, 16-19, 21, 23 and 24 above for a detailed argument as to the lack of suggestion or motivation to modify the teachings of Shen in the manner asserted by the Examiner. Moreover, Applicants respectfully submit that Vetro does not overcome the shortcomings of Shen and Uenoyama in providing a suggestion or motivation to modify Shen as suggested by the Examiner.

In summary, Applicants respectfully submit that Shen, Uenoyama and Vetro, alone in combination, do not show or suggest all of the limitations of independent Claims 1, 8, 19 and 25. Claims 5, 6 are dependent on Claim 1 and recite additional limitations. Claims 12 and 15 are dependent on Claim 8 and recite additional limitations. Claim 22 is dependent on Claim 19 and

recites additional limitations. Claims 26-29 are dependent on Claim 25 and recite additional limitations.

Therefore, Applicants respectfully submit that the basis for rejecting Claims 5, 6, 12, 15, 22 and 25-29 under 35 U.S.C. § 103(a) is traversed.
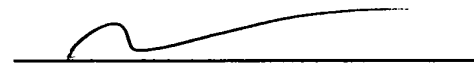
CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims. Based on the arguments presented above, Applicants respectfully assert that Claims 1-12, 14-19 and 21-29 overcome the rejections of record, and therefore Applicants respectfully solicit allowance of these claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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